

REMARKS

Claims 80-142 are currently pending in this application. Claims 107-142 have been canceled in the above amendment, without admission or prejudice to Applicants' right to pursue the subject matter of those canceled claims in either this or other (*e.g.*, related continuing) applications. Hence, claims 80-142 will be pending upon the entry of this amendment. No new matter has been introduced. The entry and consideration of the amendment are therefore respectfully requested.

**A. The Newly Submitted Claims
Have Been Canceled Without Prejudice**

Claims 107-142, which were introduced by Applicants previous amendment of July 20, 2006, have been withdrawn as directed to non-elected subject matter. In particular, the Office Action states that these claims "are directed to an invention that is independent or distinct from the invention originally claimed." Office Action at page 2. Applicants respectfully traverse the restriction of these claims to a different invention group. Nevertheless, in order to expedite an allowance of this application, claims 107-142 have been canceled in this amendment. The claims have been canceled without concession or admission as to the propriety of the restriction, and without prejudice to Applicants' right to pursue the subject matter of those claims in either this or other applications; including related divisional or other continuing applications.

**B. The Rejection for Obviousness-Type Double Patenting
Has Been Obviated and Should Be Withdrawn**

Claims 80-106 remain rejected under the non-statutory doctrine of obviousness-type double patenting, as unpatentable over claims 1-17, 19-26 and 28-66 of U.S. Patent No. 5,965,161 ("the '161 patent"). Applicants respectfully traverse this rejection, and submit that it should be withdrawn. Nevertheless, a Terminal Disclaimer is submitted with this response in accordance with the requirements of 37 C.F.R. § 1.321(c). The Terminal Disclaimer disclaims the terminal part of the statutory term of any patent granted on this application which would

extend beyond the expiration date of the '161 patent's full statutory term, except as specifically provided in the Terminal Disclaimer document.¹

Applicants submit that, in view of the foregoing, the rejection for obviousness-type double patenting has been obviated, and respectfully request that the rejection be withdrawn.

**C. The Rejection Under 35 U.S.C. § 103
Has Been Obviated and Should Be Withdrawn**

Claims 80-106 remain rejection under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,472,712 by Oshlack *et al.* ("the '712 patent") in view of U.S. Patent No. 4,64,378 by Hussain. Applicants respectfully submit that this rejection should be withdrawn, for the reasons set forth below.

The primary reference cited in the rejection – *i.e.*, the '712 patent – is a U.S. patent that did not issue until December 5, 1995 from an application – Serial No. 08/081,618 ("the '618 application") – filed on June 23, 1993 and claiming priority to December 24, 1991. Although the instant application claims priority as a continuation-in-part of the '618 application, the Examiner argues that it is not entitled to that priority, and that the '712 patent is available as prior art under 35 U.S.C. § 102(e).

Without commenting or admitting to the Examiner's statements regarding this application's entitlement to its priority dates, Applicants respectfully point out that 35 U.S.C. § 102(e) states, in relevant part (emphasis added), that:

A person shall be entitled to an invention unless –

(e) the invention was described in ... (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

¹ The submission of the Terminal Disclaimer is made without prejudice or admission, in order to expedite and facilitate an allowance of this application. See *Ventana Med. ys. v. Biogenex Labs.*, 473 F.3d 1173, 1184 n.4 (Fed. Cir. 2006); citing *Qud Envtl. Techs. Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874, 20 USPQ.2d 1392, 1394-95 (Fed. Cir. 1991) ("the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection."). See also, *Ortho Pharmaceutical Corp. v. Smith*, 959 F.2d 936, 941-942, 22 USQP.2d 1119 1124 (Fed. Cir. 1992).

Hence, the '712 patent is prior art against this application under 35 U.S.C. § 102(e) only if it is a patent "by another" – *i.e.*, if not all inventors are the same. *See* M.P.E.P. § 2136.04 (Eight Edition, Rev. 5, August 2006).

The inventorship of this application is the same, however, as that of the '712 patent. In particular, Applicants respectfully direct the Examiner's attention to the Petition to Correct Inventorship Of Non-Provisional Application Under 37 C.F.R. § 1.48(c), which is submitted with this Response (hereinafter referred to as the "Petition"). The Petition explains that the amendments to the claims of this application subsequent to filing have necessitated the addition of Frank Pedi, Jr. as a named co-inventor. Hence, the inventors of the subject presently claimed in this application are Benjamin Oshlack, Mark Chasin, and Frank Pedi, Jr. These are the same inventors of the '712 patent. Hence, the inventorship of this application is identical to that of the '712 patent, and it is not a patent "granted on an application for patent by another."

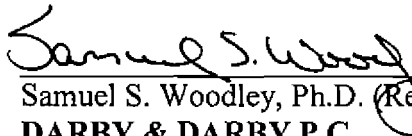
For the foregoing reasons, Applicants respectfully submit that the rejection for obviousness under 35 U.S.C. § 103/102(e) is improper and should be withdrawn.

CONCLUSION

Applicants respectfully submit that the foregoing remarks overcome and/or obviate each basis for rejection set forth in the Office Action. The pending claims as amended are all believed to be in immediate condition for allowance. Accordingly, the withdrawal of all objections and rejections is respectfully requested. An allowance is earnestly sought.

Respectfully submitted,

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Samuel S. Woodley, Ph.D. (Reg. No. 43,287)
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant